

## REMARKS

Claims 1-5 and 18-32 are pending in the application. Claims 1-5 and 18-32 stand rejected. Claims 1-5 and 18-32 remain pending. No amendments to the claims have been made. For at least the reasons provided below, the application is in condition for allowance. Applicant therefore respectfully requests reconsideration and allowance of each of the pending claims.

### **Statement Regarding Substance of Telephone Interview with Examiner**

Applicant thanks the Examiner for his time during the telephone interview conducted on July 19, 2007, in which the Examiner requested Applicant to submit written arguments for overcoming the rejections, which the Examiner stated would be carefully considered.

### **Provisional Nonstatutory Obviousness-Type Double Patenting**

Claims 1-5 and 18-32 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 18, 19 and 22 of co-pending Application No. 10/728,647. Applicant has submitted herewith a terminal disclaimer to obviate the double patenting rejection. This rejection is therefore believed to be overcome.

### **Rejections under 35 U.S.C. § 102(b)**

Claims 1-5, 20, 24, 26-29, 31 and 32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Applicant's admissions in paragraph 7 of the first Brower Declaration, substantially for the reasons set forth in Paragraph 6 of Paper No. 20070307, together with additional observations concerning the recently filed Supplemental Brower Declaration. Specifically, the Examiner asserts that "the Brower Supplemental Declaration also fails to indicate what was the earliest date that the claimed article(s) were first offered for sale, which is the moment that sets the 102(b) bar one year clock running, not the date on which the first sale was consummated." OA, page 2.

35 U.S.C. § 102(b) states that "[a] person shall be entitled to a patent unless—(b) the invention was ... on sale in this country, more than one year prior to the date of the application for patent in the United States." This "on sale" bar has been interpreted to cover actual sales, as well as offers for sale where the invention is ready for patenting at the time of the offer. *See Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55 (1998).

In this case, the only evidence relied on by the Examiner to establish the potential for a *prima facie* case of an “on sale” bar is Applicant’s statement in paragraph 7 of the first Brower Declaration, which states that “[i]n 1999 WRS ... began selling the Fast Patch, which was the first commercial embodiment of the invention disclosed in the ‘166 application.” This statement does not mention anything about offers for sale of the invention and there is nothing anywhere in the record that evidences if or when any offers for sale were made. Accordingly, Applicant’s Supplemental Brower Declaration, which explained that “the date of first sale of the Fast Patch wall patch ... was on or around September 16<sup>th</sup> 1999” was sufficient to clarify the issue raised by the first Brower Declaration with respect to the date of first sale and thereby overcome the alleged potential “on sale” bar. There is simply no evidence of a statutory bar to patentability, and therefore no *prima facie* case has been established.

Applicant nonetheless submits herewith a Second Supplemental Declaration of Jerry E. Brower which further clarifies that there are no statutory bars to the present invention based on Applicant’s offer for sale, sale, public use or display of the invention. Applicant expressly states that no offers for sale, sales, or public use or display of the invention occurred before June 16, 1999. Since no such activity occurred more than one year before either possible priority date, no “on sale” bar to patentability exists. Applicant has further stated affirmatively that he is unaware of any possible statutory bars to the issuance of a patent on the present application. Accordingly, not only is there no evidence of an “on sale” bar to the patenting of Applicant’s invention, any possible argument for an on sale or other bar has been refuted. These rejections are therefore overcome.

Claim 18 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Owens et al., substantially for the reasons set forth in paragraph No. 10 of Paper No. 033105. Owens et al., however, fails to teach or suggest a wall patch that comprises a sheet of film with a substantially uniform thickness having an adhesive layer on one surface and a paintable layer on the other surface. Owens et al. instead teaches a patch structure that comprises a “composite material” made up of multiple layers of different materials that has a exposed surface of the sheet that is “slightly convex.” See, e.g., col. 3, lines 9-24; FIG. 2; col. 4, lines 5-9. Owens et al. therefore teaches a wall patch having an adhesive layer that is separated from an outer layer by several intermediate patch structures rather than a patch that has an adhesive layer and a paintable layer

on opposing sides of the same sheet of film. Owens et al. fails to teach the patch of claim 18. Claim 18 and each of its dependent claims are therefore in condition for allowance.

**Rejections under 35 U.S.C. § 103(a)**

Claims 19, 25 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Owens et al. taken either individually or in view of either Applicant's admissions in the specification at page 1, lines 25-28 and page 2, lines 3-4, or alternatively in view of Swallow, substantially for the reasons previously of record such as set forth in Paragraph No. 13 of Paper No. 033105. Claim 18 is distinguishable over Owens et al. for the reasons discussed previously and each of these dependant claims are therefore also patentable over Owens et al. in combination with the other art of record. In addition, however, in the Office Action dated March 12, 2007, for instance, the Examiner has previously recognized that "the Brower Declaration makes out a convincing argument not only for commercial success ..., but also for solving a long felt need." OA (3/12/07), page 3. Applicant has therefore established the non-obviousness of these claims, and claims 19, 25 and 30 are therefore in condition for allowance.

Claims 21-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Owens et al. taken either individually, or in view of Estrada. Again, however, Owens fails to teach the limitations of the base claim and Applicant has previously submitted substantial evidence of non-obviousness. Claims 21-23 are also therefore in condition for allowance.

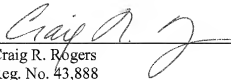
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**Conclusion**

For at least the foregoing reasons, reconsideration and allowance of claims 1-5 and 18-32 in the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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